

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

PA4407US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number

10/733,808

Filed

2003-12-10

First Named Inventor

Chris A. Hopen

Art Unit

2454

Examiner

Joshua Joo

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 50,565

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

/Tam Thanh Pham/

Signature

Tam Thanh Pham

Typed or printed name

650-812-3400

Telephone number

August 21, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.: 10/733,808

FILED: December 10, 2003

APPLICANTS: Chris A. Hopen et al.

TITLE: Network Appliance For Balancing Load and Platform Services

EXAMINER: Joshua Joo

GROUP ART UNIT: 2454

CONF. NO.: 8851

ATTY.DKT.NO.: PA4407US

BRIEF IN SUPPORT OF PRE-APPEAL REQUEST FOR REVIEW

The Examiner maintains his rejections of independent claims 1, 11, and 20 under 35 U.S.C. §103(a) as unpatentable over U.S. patent number 6,128,279 (hereinafter *O'Neil*) in view of U.S. patent application number 2003/0212788 (hereinafter *Wilding*). *Advisory Action*, 2. The Applicants respectfully traverse these rejections.

The Examiner Fails to Establish a Prima Facie Case

To support a conclusion that the claim would have been obvious requires that all the claimed elements were known in the prior art and that one skilled in the art could have combined those elements. See *KSR v. Teleflex*, 127 S.Ct. 1727, 1739 (2007); see also MPEP § 2143. *O'Neil* and *Wilding* – individually and collectively – fail to disclose at least ‘a load balancer stored in memory and executable by a processor to perform load balancing on received communications based on at least the working status of the at

least one platform service,’ wherein ‘the working status’ refers to ‘running, not running, or starting.’

Load Balancing . . . Based on . . . Running, Not Running or Starting

Ascertaining the differences between the prior art and the claims at issue requires considering both the invention and the prior art references **as a whole**. MPEP § 2141.02. When read as a whole, the claimed invention is not merely “monitoring a working status,” as posited by the Examiner. *May 27, 2009 Office Action*, 3, ¶ 8. The claims, when read as a whole, clearly require that ‘load balancing’ be ‘based on at least the working status’ of ‘running, not running, or starting.’

Neither O’Neil nor *Wilding* collectively disclose the Applicants’ claimed ‘load balancing’ based on ‘working status’ of ‘running, not running, or starting.’ With respect to O’Neil, the Examiner expressly admits that O’Neil “does not explicitly teach of a working status indicating that the at least one platform service is running, not running, or starting.” *May 27, 2009 Office Action*, 3, ¶ 7. With respect to *Wilding*, the Examiner notes instances of ‘working status,’ but fails to cite to any ‘load balancing’ based on ‘working status’ of ‘running, not running, or starting.’

Wilding merely teaches a “generic control interface” that can “assess the service’s operability, aliveness, and availability” “without requiring a detailed understanding of the specific operations necessary for controlling or monitoring the specific service.” *Wilding*, Abstract. *Wilding* notes that “[i]n the event that a fault monitor detects an abnormality in the service that it is monitoring, the fault monitor takes corrective action.” *Wilding* [0027]. Such corrective action may include “start the service,” “send a notification to the system administrator to alert the administrator to the absence of the service,” or “wait a short period of time and then re-evaluate the service to determine if the service has returned to an available status, failing which it may notify the system

administrator.” *Wilding* [0036]. None of the “corrective actions” of *Wilding* and that the Examiner appears to correlate to the Applicants’ claimed ‘working status’ involve any **load balancing**; any such correlation is, therefore, in error. Notwithstanding, there is no reason to combine *Wilding* with any aspect of ‘load balancing’ (regardless of whether it is disclosed in the art) other than to derive the Applicants’ claimed invention, which is an obvious and impermissible use of hindsight analysis.

The Examiner does not dispute that “[n]either *O’Neil* nor *Wilding* teach of (sic) the claimed load balancing based on a working status indication that the platform service is running, not running, or starting.” *Advisory Action*, 2. The Examiner argues, instead, that Applicant’s argument for reading the claim language as a whole is “arguing against the references individually.” *Advisory Action*, 2. The Applicant respectfully disagrees. The Applicants’ previously presented argument in addition to the aforementioned remarks clearly indicates that the Applicants have considered the references as a whole.

The Applicants respectfully submit that the Examiner’s Section 103 arguments indicate a failure to consider the references **and the claimed invention** as a whole. See *May 27, 2009 Office Action*, 3, ¶ 7; see also *Advisory Action*, 2. As such, the rejection runs contrary to the MPEP’s admonition that individual claim terms not be cherry-picked or read in isolation. See MPEP § 2141.02. Such distillation of claim language is improper and “disregards the statutory requirement that the invention be viewed ‘as a whole.’” *Jones v. Hardy*, 727 F.2d 1524, 1530 (Fed. Cir. 1984).

When viewed and considered as a whole, the claimed invention clearly requires that ‘load balancing’ be based on ‘working status’ of ‘running, not running, or starting,’ which is not disclosed in *O’Neil* or *Wilding*, individually or in combination.

Lack of Motivation to Combine

Pursuant to the Supreme Court's decision in *KSR v. Teleflex*, the Examiner must still provide some basis for a proposed combination (*i.e.*, motivation) regardless of whether the elements were previously known to exist in the art. "[K]nowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references to reach the particular claimed method." *Innogenetics, N.V. v. Abbot Labs.*, 512 F.3d 1363 (Fed. Cir. 2008) (affirming that "[a] generalized motivation to develop a method is not the kind of motivation required by the patent laws").

A mere conclusory statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art "because the references relied upon teach that all aspects of the claimed invention were individually known in the art is **not sufficient** to establish a *prima facie* case of obviousness without some **objective reason to combine** the teachings of the references." *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (emphasis added); see also MPEP § 2142.01(iv). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). The Applicants respectfully submit that the Examiner has used impermissible hindsight to reach a conclusion of obviousness, since the Examiner has picked a reference (*i.e.*, *Wilding*) that has nothing to do with 'load balancing' in an (albeit failed) effort to disclose the 'working status' that is admittedly missing from *O'Neil*. Further, as *Wilding* does not have anything to do with 'load balancing,' the incorporation of such would change the operation and purpose of *Wilding*. See *Wilding*, Abstract.

CONCLUSION

Because both *O'Neil* and *Wilding* fail to teach the claimed 'load balancing' 'based on at least the working status' of 'running, not running, and starting,' *O'Neil* and *Wilding* therefore fails to teach each and every claim limitation of the independent claims. Any claim dependent upon the aforementioned independent claims —either directly or via an intermediate dependent claim—is allowable for at least the same reasons as the independent claim from which it depends. As such, each and every one of the dependent claims of the present application are also in condition for allowance. For at least these reasons, the Examiner's rejection should be withdrawn.

Respectfully submitted,
Chris A. Hopen et al.

August 21, 2009

By: /Tam Thanh Pham/
Tam Thanh Pham (Reg. No. 50,565)
CARR & FERRELL LLP
2200 Geng Road
Palo Alto, CA 94303
T: 650.812.3400
F: 650.812.3444